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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,076

11/14/2005

Adam Rubin

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09/24/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,076	<b>Applicant(s)</b> RUBIN ET AL.	
	<b>Examiner</b> ALEX NOGUEROLA	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04/12/2005 (preliminary amendment).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)               |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application     |
| Paper No(s)/Mail Date <u>4/12/2005</u> .   | 6) <input checked="" type="checkbox"/> Other: <u>IDS of 8/02/05</u> . |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wiktorowicz et al. US 6,214,191 B1 ("Wiktorowicz").

Wiktorowicz discloses a micro fluid biomolecule separation system (abstract) comprising a primary separating path (160) and one or more secondary process paths (170), said primary separating path being in the form of a separating coating carried on a substrate (col. 06:61-67 and col. 10:01-08), wherein said separating coating comprising one or more separating layers (col. 10:01-08), at least one separating layer

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consisting of or comprises one or more pH active components comprising pH active groups defined as chemical groups that are capable of being protonated or deprotonated in aqueous environments (col. 06:61-67 and col. 10:01-08), said fluid biomolecule separation system comprises means for applying a voltage over the primary separating path (col. 07:35-52), the or each secondary process path(s) comprising one or more inlets in liquid communication with the primary separating path, said one or more inlets being placed along or extends along the primary separating path (note inlets for microchannels 170 along upper edge 126a), whereby biomolecules separated along the primary path is capable of being introduced into the secondary process path(s) for being processed further (col. 07:47-54).

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al. US 6,676,819 B1 ("Liu").

Liu discloses a micro fluid biomolecule separation system (abstract and col. 01:34-44) comprising a primary separating path (14) and one or more secondary process paths (60), said primary separating path being in the form of a separating coating carried on a substrate (col. 10:60 – col. 11:26), wherein said separating coating comprising one or more separating layers (col. 10:60 – col. 11:26), at least one separating layer consisting of or comprises one or more pH active components

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comprising pH active groups defined as chemical groups that are capable of being protonated or deprotonated in aqueous environments (col. 10:60 – col. 11:26 and col. 02:30-60), said fluid biomolecule separation system comprises means for applying a voltage over the primary separating path (col. 10:18-30 and col. 13:01-09), the or each secondary process path(s) comprising one or more inlets in liquid communication with the primary separating path, said one or more inlets being placed along or extends along the primary separating path (note inlets for microchannels 60 especially in Figures 5, 6, 8, 9A, 9B, and 10-12), whereby biomolecules separated along the primary path is capable of being introduced into the secondary process path(s) for being processed further (col. 13:15-30 and col. 14:05-15).

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. US 6,974,526 B2 (“Lee”).

Lee discloses a micro fluid biomolecule separation system (abstract) comprising a primary separating path (3) and one or more secondary process paths (4), said primary separating path being in the form of a separating coating carried on a substrate (col. 05:45-50 and claims 2 and 9), wherein said separating coating comprising one or more separating layers (col. 10:60 – col. 11:26), at least one separating layer consisting of or comprises one or more pH active components comprising pH active groups

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defined as chemical groups that are capable of being protonated or deprotonated in aqueous environments (col. 10:60 – col. 11:26), said fluid biomolecule separation system comprises means for applying a voltage over the primary separating path (col. 04:21-24), the or each secondary process path(s) comprising one or more inlets in liquid communication with the primary separating path, said one or more inlets being placed along or extends along the primary separating path (see Figures 2-9), whereby biomolecules separated along the primary path is capable of being introduced into the secondary process path(s) for being processed further (col. 02:01-19 and claim 7).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alex Noguera/  
Primary Examiner, Art Unit 1795

September 21, 2008